

Application Serial No. 10/801,401

Applicants' Appeal Brief Under 37 C.F.R. § 41.37

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

**Appl. No.** : 10/801,401  
**Applicant(s)** : Clements, Jehan  
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and Kit*

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**APPEAL TO THE BOARD OF PATENT APPEALS AND  
INTERFERENCES UNDER 37 C.F.R. § 41.37**

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The Examiner mailed a final rejection on March 4, 2009, setting a three-month shortened statutory period for a response. Applicant filed a response to the final rejection and notice of appeal on July 30, 2009 with a petition for a two month extension of time and the necessary fees.

5 Under 37 C.F.R. § 41.37, the time for filing an appeal brief expires on September 30, 2009 -- two months after filing of a notice of appeal. As a result, this Appeal Brief is timely. Applicant respectfully notes that this Appeal Brief is filed under the current rules contained in 37 C.F.R. § 41.37 (and not the "new format" which is not yet in effect).

In view of the following arguments, Applicant respectfully requests reconsideration and  
10 withdrawal of the outstanding rejections, and allowance of the pending claims.

**I. REAL PARTY IN INTEREST (37 C.F.R. § 41.37(c)(1)(i))**

The real party in interest is Jehan Clements, Applicant and Appellant.

**II. RELATED APPEALS AND INTERFERENCES (37 C.F.R. § 41.37(c)(1)(ii))**

There are no related Appeals or Interferences known to Appellant that will directly affect,  
15 be affected by, or have a bearing on the Board of Patent Appeal and Interference's ("BPAI") decision in the instant appeal. No continuations have been filed.

**III. STATUS OF CLAIMS (37 C.F.R. § 41.37(c)(1)(iii))**

Claims 21-24, 26-29, and 31-34 attached to Appendix 1 are pending and presently on appeal. Claims 1-20, 25, 30, and 35 have been previously cancelled.

20 **IV. STATUS OF AMENDMENTS (37 C.F.R. § 41.37(c)(1)(iv))**

There are no outstanding amendments to the claims, specification or drawings. After

Final Rejection, Applicant submitted amendments to Claims 21, 26 and 31 in Applicant's Supplemental Amendment dated August 18, 2009 in response to the Examiner's Advisory Action Before the Filing of an Appeal Brief sent August 14, 2009 (the "Advisory Action"). The Supplemental Amendment presented the rejected claims in better form for consideration on  
5 appeal pursuant MPEP § 1206. The Examiner entered the proposed amendments to Claims 21, 26, and 31 for the purposes of this appeal in his Advisory Action Before the Filing of an Appeal Brief sent September 14, 2009. Accordingly, there are no outstanding amendments to the claims.

## **V. SUMMARY OF CLAIMED SUBJECT MATTER (37 C.F.R. § 41.37(c)(1)(v))**

### **1. General Overview of the Claimed Subject Matter**

10 The present claims generally cover a computerized system, method or a kit for producing a storytelling book. A computer accepts a user's inputs in a series of blank story book screens. The inputs that a user is permitted to enter in each blank story book screen represent the minimum amount of inputs that are necessary for the computer to automatically generate a particular type of storytelling book (*i.e.*, one where the images and text are oriented in diametric  
15 contraposition). The first set of inputs comprises title and author information and one or more images; the second set of inputs comprises one or more images and corresponding text. From the first set of inputs, the computer automatically generates (1) a cover page for printing on a first sheet of paper's (or "leaf's") front-side; and (2) a title page for printing on the first leaf's back-side and second leaf's front-side. From the second set of inputs, the computer  
20 automatically generates (1) a first story page containing the one or more images proportionally enlarged for printing on the second leaf's back-side; and (2) a second story page containing the one or more images and corresponding text for printing on a third-leaf's front-side, wherein the one or more images and text on the second story page appear in diametric contraposition to the

one or more images on the first story page. The computer also automatically generates one or more indicia on the title page and first and second story pages that indicate how to assemble the second story page in diametric contraposition to the first story page. The computer then allows the user to print the pages for binding the second story page in diametric contraposition to the first story page.

Diametric contraposition orientation is characterized as having, for example, sequentially-numbered pages, the first even-numbered page of the first sheet of paper (or "leaf") within the book having an illustration of a portion of a story, with each successive even-numbered page of each successive leaf carrying another illustration portion of the story, so that the even-numbered pages, taken as a set, illustrate substantially the entire story. Diametric contraposition orientation is further characterized as having the next consecutive odd-numbered page of each leaf within the book having a copy of the same illustration that appears on the adjacent previous even-numbered page, along with textual material that correlates to said illustrations. In such an arrangement, an audience listening to the story sees the illustrations on the even-numbered pages, and the storyteller/reader sees the same illustrations and text on the next respective consecutive odd-numbered pages. Thus, aspects of the present invention allow a user to print a book from which the user or others (*e.g.*, young students/kindergarten teachers) may read, for example, from pages 3, 5, 7, 9 etc. while the audience (*e.g.*, other young students) sees pages 2, 4, 6, 8, etc at the same time.

## **2. Summary of Independent Claim 21**

Independent claim 21 (*Appendix 1*) is directed to a system for producing a storytelling book in accordance with aspects of the present invention that includes a software program in a computer having subroutines (§§ 0004, 0018). The computer accepts inputs from a user through



blank story book screens (¶¶ 0004, 0014-0016, 0018, 0020, and 0026; *Appendix 3* Fig. 1). The computer will automatically generate a cover page for printing on a first leaf's front-side based on user input of title information, author information and one or more images (¶¶ 0014, 0020-0022, and 0036; *Appendix 3* Fig. 2). The computer will automatically generate a title page for printing on the first leaf's back-side and a second leaf's front-side based on user input of title information, author information and copyright notice information (¶¶ 0015, 0022-0024, 0036; *Appendix 3* Fig. 3).

The user will create his or her story by inputting images and corresponding text into the blank story book screens (¶¶ 0016, 0026, and 0029; *Appendix 3* Fig. 4). The computer will automatically generate a first story page for printing on the second leaf's back-side from the user's inputted images and will automatically enlarge the images to their maximum size that does not overlap the margins (¶¶ 0018-0019, 0033-0035, 0037-0038, 0042, and 0044-0046). The computer will further automatically generate a second story page for printing on the third leaf's front-side from the user's inputted images and corresponding text and where the images are the same as those contained on the second leaf's back-side (¶¶ 0018-0019, 0037-0038, and 0044-0046; *Appendix 3* Fig. 5). When the one or more images and text of the second story page are printed on the third leaf's front side, the second story page appears in diametric contraposition to the one or more images of the first story page printed on the second leaf's back-side (¶¶ 0017, 0019, 0037-0038, 0047, and 0051; *Appendix 3* Figs. 5 and 6).

The computer further automatically generates indicia on the title page, and first and second story pages for indicating how to assemble the second story page in diametric contraposition to the first story page (¶¶ 0025, 0030, and 0039-0040; *Appendix 3* Figs. 3, 4, 5 and 6). The computer also allows the user to print the cover page, the two title pages, and the first

and second story pages, wherein the first story page and second story page are printed for binding the second story page in diametric contraposition to the first story page (§§ 0043-0047; *Appendix 3* Fig. 6).

### 3. Summary of Independent Claim 26

Independent claim 26 (*Appendix 1*) is directed to a method for producing a storytelling book with elements that are substantially similar to independent claim 21 (§ 0056; *Appendix 3* Fig. 7). Differences between independent claims 21 and 26 are that in claim 26 the computer provides the inputs from the user to a software program run in the computer and prints the cover page, title page, and first and second story pages (whereas in claim 21, the computer *allows* a user to print).

### 4. Summary of Independent Claim 31

Independent claim 31 (*Appendix 1*) is directed to a kit for producing a storytelling book with elements that are substantially similar to independent claim 21 (§§ 0004, 0048, and 0055). A difference between independent claims 21 and 31 is that claim 31 includes a front cover that houses the printed cover page and binds with the printed title page, first story page, second story page, and a back cover.

## VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL (37 C.F.R. § 41.37(c)(1)(vi))

The grounds of rejection to be reviewed on appeal are based on the rejection of claims 21-24, and 26-29 under 35 U.S.C. § 103(a), contained in the Final Office Action dated March 4, 2009 (the "Office Action") and, again, in the Advisory Action, as being unpatentable over *Gonzales*, (U.S. Patent Publication No. 2002/0161603) in view of *Socca* (U.S. Patent No. 6,126,202), *Clements '172* (U.S. Patent No. 6,210,172) and *Schubert* (U.S. Patent No. 5,127,879). In addition, further grounds for rejection to be reviewed on appeal are based on the

rejection of claims 31-34 under 35 U.S.C. § 103(a), contained in the Office Action, as being unpatentable over *Gonzales, Scocca, Clements '172, Schubert* and Schach (U.S. Patent No. 5,397,156).

## VII. ARGUMENT (37 C.F.R. § 41.37(c)(1)(vii))

5           The cited prior art references, individually or taken as a whole, do not disclose or suggest all the aspects of claims 21-24, 26-29, and 31-34. The Examiner also has not provided sufficient evidence that one of ordinary skill in the art would have been motivated to combine the prior art references. Accordingly, the Examiner has not established a *prima facie* case of obviousness of the pending claims and the rejections should be reversed.

10           In addition, there would have been no reason for a person having ordinary skill in the art to modify the references as suggested by the Examiner because the proposed combination would completely alter the principles of operation of at least one of the prior art references. Moreover, modification of the references would be contrary to the explicit teachings in at least one of the references. Consequently, the Examiner is taking isolated components from each reference to  
15           make a combination that was not contemplated by *any* reference and is gleaned only from the Applicant's specification using impermissible hindsight reconstruction.

### 1. The Prior Art References

The Examiner cites *Gonzales, Scocca, Clements '172*, and *Schubert* as the basis for rejecting claims 21-24, and 26-29 on § 103(a) grounds (Office Action, p. 2, ¶ 3).

20           *Gonzales* describes a webpage publishing system focused on the distributed workflow of publishing articles on a web site (*Gonzales*, ¶¶ 0033-0034). The system describes the roles of Author, Editor, and Publisher having varying privileges and responsibilities (*Gonzales*, ¶¶ 0035-0036). A user of the system described in *Gonzales* operates the publishing system through

workstations connected to the internet to access a website to create, alter, post and expire content (*Gonzales*, ¶¶ 0034, and 0039-0040). The term “publish” in *Gonzales* means to “to post material to the site, *i.e.*, to ‘go-live’ on the site” (*Gonzales*, ¶ 0032). Authors have the ability to create articles to be posted on the website, add content to articles, edit articles and delete articles. In  
5 creating an article, Authors use web page templates, and insert content into the templates (*Gonzales*, ¶¶ 0019, and 0052; Fig. 5). Content as described in *Gonzales* includes text, web links, images, sound, video or animation, as well as navigation elements, shopping cart applications, and catalog elements (*Gonzales*, ¶¶ 0051, and 0070-0078).

In accordance with *Gonzales*, once an article is ‘published’, the article appears ‘live’ on a  
10 World Wide Web site for internet users to browse (*Gonzales*, ¶¶ 0032, 0038, 0040, 0042, and 0046). The system in *Gonzales* operates in a “*what you see is what you get*” (“WYSIWYG”) manner. Specifically, content inputted into the templates, once published, appear as they are inputted (*Gonzales*, ¶¶ 0068-0071; Figs. 2, 5 and 6). *Gonzales* fails to disclose or teach a storytelling book or any other type of book.

15 *Scocca* describes a book publishing kit for children that provides cover and book page templates for children to manually complete (*Scocca*, 1:6-8, and 1:37-44; Figs. 4-7). After users of the kit manually fill in the necessary content, the pages are mailed back to the publisher for assembly into book form (*Scocca*, 3:39-47). The kit described in *Scocca* includes a sheet entitled “Home Publisher Instruction Sheet” that provides a user of the kit instructions on how to write  
20 and draw according to the disclosed publishing system (*Scocca*, 2:13-31; Fig. 1). The instruction sheet is separate from the book pages making up the finished book product. Page numbers may be provided to match illustrations with their proper respective pages (*Scocca*, Fig. 6; 2:65-3:3), but the instruction sheet does not describe the use of page numbers. *Scocca* fails to teach using

indicia contained on the story pages themselves to indicate how to assemble the book.

*Clements '172* describes a “do-it-yourself” storytelling book invention wherein the facing book pages are ordered in diametric contraposition to allow a listener of the story to observe graphic illustrations while presenting to the storyteller or reader the same or corresponding graphic with accompanying text (*Clements '172*, Abstract; 1:14-22, 4:61-5:18, and 5:25-31; Figs. 1, 2 and 5). In creating a storybook described in *Clements '172*, a user illustrates a story on a series of insertion pages where each successive insertion page contains at least one picture, and possibly some text (*Clements '172*, 6:11-14; Fig. 5). The insertion pages may be created by hand, and the insertion pages are preferably one-sided for use with clear loose-leaf holders having stiff opaque inserts between the two leaves of one-sided sheets of paper (*Clements '172*, 5:66-69, 6:14-26, and 6:54-67). As taught by *Clements '172*, a single one-sided insertion page is inserted into one side of a clear loose-leaf holder and another single one-sided insertion page is inserted into the opposite side of the clear loose-leaf holder (*Clements '172*, 6:49-53; Fig. 1 and 2). To complete the invention, several of these clear loose-leaf holders containing insertion pages are arranged in diametric contraposition (*Clements '172*, 6:49-53). Instructions may be provided on the insertion pages to specify where story content should be placed (*Clements '172*, 6:24-48).

*Schubert* describes a record keeping system comprised of an accordion-folded strip of paper extending between a front and back cover (*Schubert*, 2:32-39). The strip of paper in the record keeping book is treated with carbonless treatment. The carbonless treatment is “male” or “female” depending on which side of the paper is treated and whether the treated portion is on the left or right side of the paper. The left and right portions become copies of one another when information is entered due to the carbon paper (*Schubert*, 3:9-33). *Schubert* does not teach a storytelling book or providing assembly of a book in diametric contraposition.

The Examiner cites *Gonzales, Scocca, Clements '172, Schubert* and *Schach* as the basis for rejecting claims 31-34 on § 103(a) grounds (Office Action, p. 8; ¶ 11).

*Schach* describes a kit that enhances the marketability of personalized books, such as paperback romance novels. The kit includes a simulated book constructed of a book cover and foam core adhesively secured to it, and a questionnaire for insertion of personalized information (*Schach*, Abstract). Figure 1 of *Schach* discloses including "Book Title" in the cover of the kit. The rear face of the simulated book cover includes instructions for completing the questionnaire (*Schach*, 4:33-48, and 4:59-65; Fig. 2). When a user of the kit completes the questionnaire, the user then sends the kit back to the seller of the kit (*Schach*, 4:59-65, and 5:17-23). Upon receiving the completed questionnaire, the seller prints a personalized book using as part of the text of the book the personalized information on the questionnaire (*Schach*, Abstract). Therefore, the questionnaire provides the content from which the seller of the book draws on to print a personalized book (*Schach*, 5:17-38). Printing and assembly of the personalized book are thus effectuated by the seller. Additionally, the instructions to fill out the questionnaire and mail back to seller are not indicia indicating how to assemble the book in diametric contraposition orientation (*Schach*, 4:33-48, and 4:59-65; Fig. 2).

## **2. The Law Regarding Obviousness**

Section 103 of Title 35 provides:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

35 U.S.C. § 103(a); *See also Graham v. John Deere Co.*, 383 U.S. 1, 14, 86 S. CT. 684 (1966); *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999).

“Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Court are as follows: (A) Ascertaining the” scope and content of “the prior art; [ ] (B) Ascertaining the differences between the claimed invention and the prior art; and (C) Resolving the level of ordinary skill in the pertinent art.” MPEP § 2141; *see also KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 399 (U.S. 2009). In order for the Examiner to make a *prima facie* showing of obviousness, the Examiner must analyze the prior art references and the differences between the claimed invention and the prior art.

Under *KSR*, the Office “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 418. However, the Court noted that an invention “composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *Id.* at 418. The factfinder must still take into account a number of factors “in order to determine whether there was an **apparent reason to combine the known elements in the fashion claimed.**” *Id.* at 418 (emphasis added); *see also In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (“In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with **no knowledge of the claimed invention**, would select the elements from the cited prior art references for combination in the manner claimed.”) (emphasis added).

Importantly, the Court explicitly cautioned against using hindsight reconstruction, where the rejection is based solely on knowledge gleaned only from applicant's disclosure and not on knowledge in the prior art at the time the claimed invention was made. The Court stated that “a factfinder should be aware, of course, of the distortion caused by the hindsight bias and must be

cautious of arguments reliant upon ex post reasoning.” *Id.* at 421, quoting *Graham*, 383 U.S. at 36 (warning against a “temptation to read into the prior art the teachings of the invention in issue” and instructing courts to “guard against slipping into the use of hindsight”) (internal citations omitted). Improper use of hindsight reconstruction occurs when the combination of references renders one or more references unsatisfactory for its intended purpose, and/or where “the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified.” MPEP §§ 2143.01(V) and 2143.01(VI); see also *In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349 (CCPA 1959) (a proposed modification or combination of prior art is impermissible if the proposed modification or combination would change the principle of operation of the prior art invention being modified).

It also has long been recognized that “when the prior art teaches away from the claimed solution. . . obviousness cannot be proven merely by showing that a known composition could have been modified by routine experimentation or solely on the expectation of success; it must be shown that those of ordinary skill in the art would have had some apparent reason to modify the known composition in a way that would result in the claimed composition.” *Ex Parte Whalen*, 2008 WL 2957928, 89 U.S.P.Q.2d 1078 (Bd.Pat.App. & Interf. 2008); see also *KSR*, 550 U.S. at 416, citing *U.S. v. Adams*, 383 U.S. 39, 51-52 (1966) (“When prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.”); see also *In re Grasselli*, 713 F.2d 731, 743 (Fed Cir 1983) (It is improper to combine references where the references teach away from their combination.); see also MPEP § 2145. A prior art reference must be considered in its entirety, *i.e.*, as a whole, including any part of the disclosure that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1552 (Fed. Cir. 1983); see also *Optivus*



*Tech., Inc. v. Ion Beam Applications S.A.*, 469 F.3d 978, 989 (Fed. Cir. 2006), and *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 1360 (Fed. Cir. 1999) (“A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.”) (internal citations omitted).

Applicant respectfully notes that in the Office Action, although the Examiner stated that “one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references,” (Office Action, p. 9, ¶ 14), the Examiner’s own analysis is entirely based on explaining what reference A purportedly shows, what reference A is lacking, what reference B purportedly shows, and how reference B purportedly provides what reference A is lacking, etc. An entire section of Applicant’s Response D to Non-final Office Action is dedicated to a discussion of all the five cited references together and, in addition, there is an entire section traversing the combination under *KSR*. Thus, Applicant did not merely attack each reference individually. Office Action, pp. 11-12, ¶ 21. Moreover, the discussion of the references were to assist in determining the scope and content of the prior art. In other words, Applicant is reading each reference for “*what it fairly teaches* in combination with the prior art as a whole” to ensure that each reference indeed discloses what the Examiner asserts that it is disclosing. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

### **3. The References of Record do not Render the Claims Obvious**

As Applicant more thoroughly describes below, one of ordinary skill in the art at the time the invention was made would not have been able to combine *Gonzales*, *Scocca*, *Clements* ’172, *Schubert*, and *Schach* to develop the claimed subject matter, nor would one of ordinary skill had reason to do so. Specifically, the rejection of the pending claims is erroneous because: (i) the

Examiner misidentified certain elements in the prior art as teaching aspects of the present invention when in fact they do not, thus, the combination of the prior art references individually or taken as a whole do not disclose what is presently claimed; (ii) the Examiner's application of *Gonzales*, along with the other prior art references, impermissibly changes the principle of operation of *Gonzales*; (iii) the prior art reference of *Clements '172* as cited by the Examiner teaches away from the present invention; and (iv) the Examiner has not provided a valid reason to explain why one of ordinary skill in the art would combined the five references as suggested by the Examiner to make the claimed subject matter without using impermissible hindsight. As such, a *prima facie* case of obviousness has not been made. Given proper consideration, the conclusion that Appellants' claims are unpatentable must be withdrawn.

**(a) The Combination of the Prior Art References Individually or Taken as a Whole Do Not Disclose What is Presently Claimed**

In addition to the more detailed discussion below, all references cited by the Examiner at least do not disclose

*automatically generating by the computer a cover page* for printing on a first leaf's front-side from the *first set of inputs*, wherein the cover page includes at least one of title information, author information, and one or more images; ...

*automatically generating by the computer a title page* for printing on the first leaf's back-side and a second leaf's front-side, wherein the title page includes the title and author information and a copyright notice information; ...

*automatically generating by the computer a first story page* from the one or more images *from the second set of inputs* for printing on the second leaf's back-side and automatically proportionally enlarging the one or more images from the second set of inputs on the first story page to a maximum size that does not overlap margins of the first story page; [and/or] ...

*automatically generating by the computer a second story page from* the one or more images and the corresponding text from the second set of inputs for printing on a third leaf's front-side, wherein the one or more images and corresponding text from the second set of inputs, when printed, appear oriented in diametric contraposition to the one or more images on the first story page....

as stated in independent claims 21, 26, and 31. In addition, the cited references would not teach one of ordinary skill in the art these limitations. In particular, the combination of cited references operate in a WYSIWYG manner. That is, what the user sees and inputs is what the software  
5 outputs on a page-edit-by-page-edit basis. On the contrary, in aspects of the present disclosure, the user inputs minimal information in two “*blank story book screens*” which results in “*automatically generating*” at least “a cover page,” “a title page” (that is printed on a first leaf’s back-side and a second leaf’s front-side), “a first story page,” and “a second story page” “*for printing... in diametric contraposition*”. In addition, the data that the user inputs is presented in  
10 different ways depending on the page (e.g., some pages have just the image proportionally enlarged, while other pages have the image and certain text). The Examiner has presented no evidence as to why one of ordinary skill in the art at the time of the invention would have significantly modified the combination of *Gonzales*, *Scocca*, *Clements* '172, *Schubert*, and *Schach* to anything other than a WYSIWYG-type invention. Accordingly, these references alone,  
15 or in combination, do not disclose nor teach the limitations stated in independent claims 21, 26, and 31 and/or the claims that depend therefrom.

(i) *Gonzales*

In the Office Action, the Examiner stated that “*Gonzales* teaches a storytelling book and method of providing a storytelling book (interactive publishing system, *Gonzales*, ¶ 0032;  
20 method, ¶¶ 0043-44).” Office Action at p.2, ¶ 4. *Gonzales* ¶ 0032 discloses that “The present invention relates to an interactive publishing system capable of supporting multiple lines of business (LOBs). Although the system may be employed for the publishing of hard copy material, such as a brochure or magazine, it is described herein in the context of a web site, where the term ‘publish’ means to post material to the site, i.e., to ‘go-live’ on the site.”

*Gonzales* ¶ 0043 also discloses, “Memory 135 holds data and instructions for execution by processor 130. In particular, memory 135 contains a program module that controls processor 130 to perform a method in accordance with the present invention as described herein. The program module is also known as a content management application.” *Gonzales* ¶ 0044 further discloses:

5           Although system 100 is described herein as having the instructions for the method of the present invention installed into memory 135, the instructions can reside on an external storage media 140 for subsequent loading into memory 135. Storage media 140 can be any conventional storage media, including, but not limited to, a floppy disk, a compact disk, a magnetic tape, a read only memory, or an optical  
10          storage media. Storage media 140 could also be a random access memory, or other type of electronic storage, located on a remote storage system and coupled to memory 140.

Accordingly, *Gonzales* merely discloses *a* system and *a* method for publishing, but in no way  
15       teaches or discloses “a system for producing a *storytelling book*” and “a method of producing *a storytelling book*,” as described in independent claims 21 and 26.

In the Office Action, the Examiner stated that *Gonzales* teaches “(a) accepting a first set of inputs from a user in a first graphical user interface screen and providing them to the software program (an Author can create an article, etc., *Gonzales* ¶¶ 0068-78).” Office Action at p. 2-3, ¶

20       4. *Gonzales* ¶¶ 0068-78, in short, discloses:

          An Author can create an article, add content to the article, edit the article and delete the article.... [T]he Author can establish or define new content, edit the content and delete the content....The Author can create a new article. A new  
25          article is a page, such as a web page, of information about a topic. The Author can edit an article that is returned to the Author by an Editor.

Claims 21 and 26 have been previously amended to read “first blank story book screen”, and thus the Examiner’s reference to “first graphical user interface screen” are no longer germane to patentability. Furthermore, *Gonzales* does not disclose any *blank story book screens*, but rather  
30       discloses a general web page publishing system (*Gonzales*, ¶¶ 0046-0058; Figs. 4-15). *Gonzales* operates in a WYSIWYG manner, and therefore, *Gonzales* fails to disclose any use of blank

story book screens in any respect, including as stated in independent claims 21, 26, and 31.

In the Office Action, the Examiner stated *Gonzales* teaches

5 “automatically generating, using said software program, a title page for printing on the first leaf’s back-side and a second leaf’s front-side, a first story page from the one or more ... images from the second set of inputs and a secondary story page from the second set of inputs including the one or more ... images and the corresponding text for printing on a third leaf’s front-side (Click a submit button to view the edited article. At this point the article is laid out in accordance with the template that the Author used to create the article, ¶ 0209) for printing on the  
10 second leaf’s back-side”.

Office Action at p. 3, ¶ 5. In aspects of the present disclosure, “the second set of inputs” effects automatic generation (i.e., in the step of “**automatically generating**”) of “a first story page, ...

and a second story page”. In addition, the “first story page” is automatically generated “for

15 printing on the second leaf’s back-side”; and the “second story page” is automatically generated “for printing on a third leaf’s front-side”. The templates in *Gonzales* cited by the Examiner refer to Figure 5, which “shows a set of several exemplary layout templates” (*Gonzales*, ¶ 0019).

Figure 5 of *Gonzales* illustrates six templates for web page publication of articles, however, none of the templates teach to generate a “first story page” for “printing on the second leaf’s back-

20 side”, and a “second story page” for “printing on the third leaf’s front-side” as disclosed in the present invention. Furthermore, *Gonzales* neither teaches nor contemplates automatically

generating story pages for printing wherein the “one or more images from the second set of inputs” is used to automatically generate *both* a “first story page” and a “second story page”.

Lastly, *Gonzales* teaches no such step of automatic generation; instead, *Gonzales* teaches that

25 what the user inputs/sees is what the software outputs (i.e., what the user gets). Therefore, *Gonzales* does not disclose the above mentioned steps of “**automatically generating**” of story pages as stated in independent claims 21, 26, and 31.

In the Office Action, the Examiner stated that *Gonzales* teaches “wherein said one or

more indicia include graphical symbols (image assets, ¶ 0051; understood to be graphics)".

Office Action at p. 8, ¶ 10. *Gonzales* ¶ 0051 discloses

5 A content component of an article can be any of text, a link (text based or image based), or an asset (e.g., image, sound, video, animation). An element of a template is a defined space within which a content component is rendered, i.e., positioned and displayed, or in the case of an active content component such as an audio clip, executed. A template may include a plurality of elements.

However, *Gonzales* does not disclose using "*indicia*" "for indicating how to assemble... in

10 diametric contraposition," as stated in independent Claims 21, 26, and 31. Since *Gonzales* is WYSIWYG publishing software, it does not disclose "*automatically generating* one or more

*indicia*" on pre-set pages for "indicating how to *assemble*... in *diametric contraposition*" as taught in the present invention. Although *Gonzales* generally discloses using "an asset (e.g.,

image" in creating web page content (*Gonzales*, ¶ 0051), it does not disclose using "graphical

15 symbols" as "*indicia*" in the manner described above and as claimed. As a result, *Gonzales* does not disclose "said one or more indicia include graphical symbols," as described in dependent claims 24, 29, and 34.

In the Office Action, the Examiner stated that

20 In response to Applicant's argument that *Gonzales* does not disclose "the first set of inputs," because an "article name or page name" is not "author information"; an "article title" – in the web page context – is the <TITLE> tag in HTML, which relates to the title of the specific page (or "article"), not the title of the entire work; in the web-page context or any other, a string of text comprising author, title, or copyright information, etc. is merely non-functional printed matter, and  
25 having no tie in function to the substrate, is not patentably distinguishable over the prior art ...[as] USPTO personnel need not give printable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate.

30 As described in aspects of the present invention, the "first set of inputs" the computer accepts operate as functional descriptive material because the inputs allow the computer to automatically generate multiple pages from a minimum amount of input that are necessary to achieve the result

of one aspect of the invention, which includes, *inter alia*, the cover and title pages. *Even if* the Examiner interprets the first set of inputs to be “nonfunctional descriptive matter,” other claimed aspects of the present invention, as illustrated in this Appeal Brief, constitute sufficient nonobvious subject matter for the pending claims to be patentable.

5 For all the reasons above, *Gonzales* does not teach nor disclose the above mentioned limitations of at least independent claims 21, 26, and 31 and the claims that depend therefrom.

(ii) *Scocca*

First, in the Office Action, the Examiner stated *Scocca* teaches “wherein the title page, and first and second story pages include one or more indicia for indicating how to assemble the  
10 second story page”. Office Action at p. 5, ¶ 5. In particular, “instructional indicia for indicating how to assemble the book (FIG. 1 is an illustration of the instruction sheet in which the contents of the invention the book publishing kit is listed....)”. Office Action at p. 4, ¶ 4. “The templates taught by *Gonzales* would also be adapted to provide a page bearing publishing instructions, such as is taught by *Scocca*”. Office Action at p. 5, ¶ 5. In addition, the Examiner stated *Scocca*  
15 teaches “instructional indicia for indicating how to assemble the book (*Scocca*, 2:13-31)”. Office Action at p. 7, ¶ 8.

As shown in *Scocca* FIG. 1, *Scocca* merely discloses a separate “instructional sheet” (*Scocca*, 2:13-15). Or as Examiner stated, *Scocca* provides “*a page* bearing publishing instructions.” Office Action at p. 5, ¶ 5 (emphasis added). In other words, *Scocca* does not teach  
20 nor disclose “one or more *indicia*... for indicating how to assemble the second story page....” And, in *Scocca*, where there are instructions, and *not indicia*, those instructions are not included on each of the “title page, and first and second story pages”. In contrast, aspects of the present invention include printing “indicia” on the substantive title and first and second story pages for showing the user how to assemble the story pages in a book.

Second, the Examiner stated in Office Action at pp. 7-8, ¶ 9 that “*Scocca* teaches where page indicium includes numbering (*Scocca*, Fig. 6, Item 49).” However, *Scocca* merely shows page numbering in Figure 6, Item 49, and not “one or more *indicia*... for *indicating how to assemble* the second story page ... wherein said one or more indicia include page numbers” as

5 presently claimed. In other words, *Scocca* does not teach to use page numbers to indicate how to assemble the book, and in particular, *Scocca* does not teach assembly of “the second story page in diametric contraposition to the first story page.”

Third, in the Office Action, the Examiner began by stating that *Scocca* taught a page of instructions (Office Action at pp. 4-5, ¶ 5). Then, in the Office Action at p. 7, ¶ 9, the Examiner

10 compared the “wherein said one or more indicia include page numbers” with page numbers disclosed in *Scocca* Fig. 6, Item 49, and 2:13-15. However, use of the word “said” refers to an antecedent use the phrase “one or more indicia”. Thus, with this well understood use of “said”, the Examiner must have meant that the instruction page taught in *Scocca* “include” page numbers. However, *Scocca* teaches no such limitation. Indeed, page numbers disclosed at *Scocca*

15 Fig. 6, Item 49 and 2:13-15 do not pertain or relate to the instruction page in any manner. As a result, *Scocca* does not teach “one or more indicia... for indicating how to assemble ... wherein said one or more indicia include page numbers” as presently claimed at claim 33.

For all the reasons above, *Scocca* does not teach nor disclose the above mentioned limitations of at least independent claims 21, 26, and 31 and the claims that depend therefrom.

20 (iii) *Clements '172*

First, in the Office Action, the Examiner stated that in *Clements '172* the “page arrangement is understood to be ‘in diametric contraposition’.” Office Action at p. 6, ¶ 6. As such, the Examiner contended that *Clements '172* teaches

automatically generating ... a second story page from the one or more images and



the corresponding text from the second set of inputs for printing on a third leaf's front-side, wherein the one or more images and corresponding text from the second set of inputs, when printed, appear oriented in diametric contraposition to the one or more images on the first story page,

5 as stated in independent claims 21, 26, and 31. However, *Clements* '172 discloses WYSIWYG by providing insertion pages for the user to insert drawings or text (i.e., each insertion page requires drawing(s) or text to be added). Accordingly, *Clements* '172 does not teach “***automatically generating***” any story pages from “inputs from a user”.

10 Second, in the Office Action, the Examiner responds to Applicant's arguments further directed to *Clements* '172 as “not persuasive” because “[t]he courts have held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.” Office Action at p. 10, ¶ 18. However, aspects of the present invention are not mere automations of *Clements* '172. Aspects  
15 of *Clements* '172 disclose using blank insertion pages, and a WYSIWYG mode of operation (*Clements* '172, 5:66–6:26). The insertion pages (which contain the pictures and text, *Clements* '172, 6:11–36) are held in place by page holders (*Clements* '172, 5:67–6:9, and 6:54–58). In contrast, aspects of the present invention, *inter alia*, do not require using insertion pages or page holders as taught by *Clements* '172. Aspects of the present invention allow the user to input data  
20 that then automatically generates multiple pages from the user input for assembly in diametric contraposition. Furthermore, *Clements* '172 at 6:24–26 discloses that “[t]he insertion pages are preferably ***one-sided*** for use with clear loose-leaf holders having a stiff opaque insert” (emphasis added). In contrast, independent claims 21, 26 and 31 all teach printing on both sides of a leaf. Thus, the present invention is not merely “providing an automatic or mechanical means to  
25 replace a manual activity which accomplished the same result.”

Third, in Response to Arguments in Office Action p. 10, ¶¶ 16 and 17, the Examiner

stated that "*Clements '172* teaches providing instructions for assembling the book pages in diametric contraposition as indicia in the story book," and in support, the Examiner cited *Clements '172* at 6:24-48, which in short states

5           ... [the] insertion page has two columns of dotted lines with the *instructions* "**Write your story using these lines**" noted in parentheses at the top of the page. On this lined corresponding insertion page, a space without lines is provided in the lower right-hand corner with the *instructions*, "**Paste a reduced size copy of your picture here**" noted in the space. (emphasis added)

10           This citation by the Examiner in *Clements '172* does not teach using *indicia* for *assembly* of a storytelling book. The instructions of "Write your story using these lines" and "Paste a reduced size copy of your picture here" are directed towards providing content for the insertion pages in *Clements '172*, and not directed towards assembly of the book. In contrast, the present invention claims "one or more *indicia* .... for indicating how to *assemble* the second story page in diametric contraposition to the first story page."

15           For the reasons above, *Clements '172* does not teach nor disclose the above mentioned limitations of at least independent claims 21, 26, and 31 and the claims that depend therefrom.

(iv) *Schach*

20           First, the Examiner stated that *Schach* teaches "a front cover that houses the printed cover page and binds with the printed title page, the first story page, the second story page, and a back cover" and cites *Schach*, 3:12-31, 4:33-48, and Figures 1 and 2 for his conclusion. Office Action at p. 8, ¶ 12. *Schach* at 3:12-31 reads

25           An exemplary kit according to the present invention is shown generally by reference numeral 10 in FIGS. 1 through 3. The kit includes a simulated book, shown generally by reference numeral 12 in FIG. 6, which typically comprises a book cover 13, and one or more pieces (thicknesses) of foam core 14, or like material (preferably white in color and simulating what the pages of a book look like from the exterior, e.g. styrofoam laminated to paper board) which is adapted to be received within the cover 13. If desired the cover 13 and foam core 14 can be secured together, as by a strip of adhesive 15 extending along one edge of the inside surface 16 of the book cover 13, which engages a similar edge of one face

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of the foam core 14, or by spray adhesive 15' covering the entire inner face of the cover, or double index tape. The simulated book preferably has substantially the same size and shape as a real paperback novel, i.e. roughly about 4.x.7 inches, and about 1/8-3/4 inch thick.

5 and *Schach* at 4:33-48 reads

10 The kit 10 may also include other sheets of paper, such as a separate sheet of detailed printed instructions, sales literature for other or related products, guarantees, or the like. For example, one particularly worthwhile insert would be a folded sheet of paper with detachable order form (to fit in reply envelope 19) which describes and allows one to order options which enhance the "basic" book. For example, for additional sums (submitted with the reply envelope and questionnaire, e.g. by check or credit card charge authorization) one could order a personal message in the book, a custom page, or by submitting one's own photo have a custom cover or photo page made (with the submitted photo on it),  
15 including a custom cover with an "oil painting" version of the submitted photo (produced by computer photo-enhancement technology).

However, nothing in the above quotes nor in the remainder of *Schach* teach that the front cover "houses the printed cover page". Nothing in the above quotes nor in the remainder of *Schach* teach that the front cover "binds with the printed title page." Figure 1 of *Schach* merely  
20 discloses the cover of the kit and the cover includes "Book Title". However, *Schach* does not teach a "printed cover page" and a "printed title page" (*Schach*, Fig. 1, reference numerals 36 and 34; *see also* 4:49-58).

Second, the instructions taught in *Schach* are for using the kit for producing a personalized romance novel using a mail-in to the manufacturer method (*Schach*, 1:38-46, and  
25 2:22-39). The instructions provided in *Schach* are for filling out the questionnaire and to mail it back to the seller (*Schach*, 4:33-48, and 4:59-65; Fig. 2). Thus, *Schach* does not teach indicia as understood in aspects of the present invention: indicia "indicating how to *assemble* the second story page in diametric contraposition to the first story page."

For the reasons above, *Schach* does not teach nor disclose the above mentioned  
30 limitations of at least independent claim 31 and the claims that depend therefrom.

**(b) *Gonzales* is Non-analogous Art, and The Examiner's Application of *Gonzales* Changes the Principle of Operation of *Gonzales***

*Gonzales* does not disclose or suggest book publishing, nor does *Gonzales* disclose the generation of a book. Rather, *Gonzales* at ¶ 0023 discloses, “Although the system may be  
5 employed for publishing hard copy material, such as a brochure or magazine, it is described herein in the context of a web site, where the term ‘publish’ means to post material to the site, i.e., to ‘go-live’ on the site.” Thus, *Gonzales* teaches web page publishing software and fails to teach generating a storytelling book (*Gonzales*, ¶¶ 0046-0058; Figs. 4-15). And while *Gonzales* teaches web publication and includes a print module, *Gonzales* does not teach the publication of  
10 a book (*Gonzales*, ¶ 0023). Moreover, the Examiner himself has referenced the “**web publishing** system such as *Gonzales*....” (Emphasis added).

Also, as illustrated above, *Gonzales* discloses a method for web publishing and not book publishing. On the other hand, aspects of the present invention contemplates that users of the storytelling book publishing software to be, but not limited to, “students in a school” or those “in  
15 a home schooling environment”. However, *Gonzales* discloses a system directed towards departments in a company, and contains complex workflow with privileges, responsibilities and roles assigned to different types of users of the various elements of the invention disclosed in *Gonzales* (*Gonzales*, p. 2, ¶¶ 0033-0036). With all this complexity, a student would find it difficult to use the system disclosed in *Gonzales*. A system incorporating *Gonzales* would detract  
20 from the ease and simplicity of the present invention as required for an audience of students. As result, *Gonzales* is non-analogous art, and it would be improper to combine the non-analogous art of web publishing software with the other prior art of *Scocca*, *Clements* '172, *Schubert* and *Schach* in an obviousness analysis. See MPEP § 2141.01(a).

Moreover, *Gonzales* employs web page templates to compose articles and post them onto

a website (*Gonzales*, ¶¶ 0033-0034). The content of these articles may include text, web links, images, sound, video animation, navigation elements, shopping cart applications and catalog elements (*Gonzales*, ¶¶ 0051, 0070-0078). To combine *Gonzales*' distributed web page publishing system with the other prior art references and yield a storytelling book system would

5 change the principle of operation of *Gonzales*. Web page publishing and book publishing have fundamental differences that are important to the obviousness analysis. Improper use of hindsight reconstruction includes the situation where the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified. MPEP §§ 2143.01(V) and 2143.01(VI); *see also In re Ratti*, 270 F.2d at 813.

10 As is well known to those of ordinary skill in the arts, web page publishing is different from book publishing because web page publishing does not consider pagination; that is, web page publishing does not concern itself with how information and content appears and is arranged in a printed book page. On the other hand, pagination is critical to book publishing and is a crucial aspect of the present invention. Furthermore, to combine *Gonzales* with the other

15 prior art references of story book publishing would change the principle of operation of *Gonzales*'s web interface, internet connectivity requirement, posting material or to "go-live" on a website, and the availability of media that do not translate into story book form (e.g. web links, sound, video, animation, navigation elements shopping cart application and catalog would be impermissible to include).

20 As described in the templates used in *Gonzales*, it is fundamental for *Gonzales* to function in WYSIWYG operation because WYSIWYG editing and previewing is essential within and between the various roles of Author, Editor, and Publisher within *Gonzales*' distributed web page publishing system (*Gonzales*, ¶¶ 0093, 0103, 0107-0109, and 0194). As a

result, *Gonzales* does not contemplate automatically generating pages let alone automatically generating book pages for printing. It would change the principle operation to take the user's WYSIWYG inputs in *Gonzales* and automatically generate pages for printing for ultimate use in a storytelling book.

5           As non-analogous art and resulting change in the principle of operation of *Gonzales* when combined with the other prior art references to yield what is presently claimed in claims 21, 26, and 31, one of ordinary skill in the art would have no reason to combine *Gonzales* with the other cited references, and combining the references would constitute improper hindsight reasoning. See MPEP §§ 2141.01(a) , 2143.01(V) and 2143.01(VI); see also *In re Ratti*, 270 F.2d at 813.

10                   **(c) The Examiner Cited a Prior Art Reference that Teaches Away From the Present Invention**

*Clements '172* when read as a whole teaches away from the present invention. "A prima facie case of obviousness can be rebutted if the applicant . . . can show 'that the art in any material respect taught away' from the claimed invention." *In re Geisler*, 116 F.3d 1465, 1469  
15 (Fed. Cir. 1997). A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore*, 721 F.2d at 1552; see also *Optivus Tech.*, 469 F.3d at 989, and *Tec Air*, 192 F.3d at 1360 ("A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction  
20 divergent from the path that was taken by the applicant.") (internal citations omitted).

              A person of ordinary skill in the art would be discouraged from applying *Clements '172* to print on both sides of a sheet because *Clements '172* specifically teaches to use only one side of a sheet of paper. In particular, *Clements '172* discloses the WYSIWYG use of blank insertion pages to create a story book (*Clements '172*, 5:66–6:26). These insertion pages are held in place

in book form by clear loose-leaf page holders (*Clements* '172, 6:11-36, 5:67-6:9, and 6:54-58; Figs. 1 and 2). The clear loose-leaf page holders may contain a stiff opaque insert to maintain their shape and provide a background for the insertion pages (*Clements* '172, 6:7-10). *Clements* '172 at 6:24-26 discloses that "[t]he insertion pages are preferably *one-sided* for use with clear loose-leaf holders having a stiff opaque insert" (emphasis added). *See also Clements* '172, 6:7-10 and 6:54-56; Figs. 1 and 2). This one-sided insertion page aspect of *Clements* '172 clearly teaches away from the present invention and leads one of ordinary skill in the art to a divergent path of using one-sided insertion pages. In contrast, independent claims 21, 26 and 31 of the present invention teach printing on both sides of a sheet. Specifically, a cover page is automatically generated for printing on the "*first leaf's front-side*," a title page is automatically generated for printing on the "*first leaf's back-side* and a *second leaf's front-side*," a first story page is automatically generated for printing on the "*second leaf's back-side*," and a second story page is automatically generated for printing on a "*third leaf's front-side*".

As a result, the fact that *Clements* '172 teaches away from the claimed invention rebuts the obviousness rejections and rationale for combining *Clements* '172 with the other prior art references to yield what is presently being claimed.

**(d) The Examiner Has Not Provided A Valid Reason To Explain Why One Of Ordinary Skill In The Art Would Have Made The Examiner's Proposed Combination.**

As stated in MPEP § 2141:

The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made *explicit*. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that "[R]ejections on obviousness *cannot* be sustained by *mere conclusory statements*; instead, there must be some articulated *reasoning* with some rational underpinning to support the legal conclusion of obviousness." *KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1396.

(emphasis added).

Even though the Examiner has not met his burden of identifying the claimed elements in

the prior art (as traversed above), the Examiner also has not provided adequate reasons to combine the cited references.

First, for combining *Scocca* to *Gonzales*, the Examiner stated “it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have adapted the publishing templates of *Gonzales* to include” various aspects of the present invention “in order to assist an amateur author in publishing a professional-looking story book” and “***to allow an amateur publisher to print and bind ‘proof’ or ‘draft’ copies of the storybook themselves, without requiring outside assistance or additional postage.***” Office Action at pp. 5-6, ¶ 5 (emphasis added).

For combining *Clements* '172 with *Scocca* and *Gonzales*, the Examiner stated “it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the templates taught by *Gonzales* to produce” various aspects of the present invention “as taught by *Clements* '172, in light of the teachings of *Scocca*, ***in order to easily allow a user to specify, preview, and remotely produce the storybook document in volume***”. Office Action at p. 6, ¶ 6 (emphasis added).

For combining *Schubert* with *Gonzales*, *Scocca*, and *Clements* '172, the Examiner stated “it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have added” aspects of the present invention “to the title page template of *Gonzales*, as taught by *Schubert*, further in light of the teachings of *Scocca* and *Clements* '172, ***in order to assist an amateur author in publishing a professional-looking storybook***”. Office Action at p. 7, ¶ 7 (emphasis added).

For combining *Schach* with *Gonzales*, *Scocca*, *Clements* '172, and *Schubert*, the Examiner stated “it would have been obvious to one of ordinary skill in the art, at the time the



invention was made, for the kit to include aspects of the present invention “as taught by *Schach*, with a software program in a computer for publishing the book, as taught by *Gonzales*, in light of the teachings of *Scocca*, *Clements* '172, and *Schubert*, ***in order to provide specialized, more durable paper to use for the cover of a story book***”. Office Action at p.9, ¶ 12 (emphasis added).

5           Despite these assertions by the Examiner, he has not provided any express reasons why one of ordinary skill in the art would have thought to combine the cited references ***to develop Applicant's solution to the problems in the prior art as claimed herein***. For example, the purported reasons to combine do not explain why one of ordinary skill in the art at the time of the invention would have a reason to combine this group of WYSIWYG-type disclosures to  
10   create, *inter alia*, an invention that inputs minimal information in two “blank story book screens” which results in “automatically generating” at least “a cover page,” “a title page” (that is printed on a first leaf's back-side and a second leaf's front-side), “a first story page,” and “a second story page” “for printing ... in diametric contraposition”.

          Rather, the Examiner has provided mere conclusory statements that say A covers X and  
15   B covers Y, so it would have been obvious to combine A and B because one would want to provide X and Y. In other words, the broad conclusory statements that the Examiner provides as purported reasons to combine the references do not give reasons for how and why one of ordinary skill in the art would read the references (at the time the invention was made) and develop Applicant's solutions to the problems in the prior art as claimed herein.

20           Second, the Examiner stated that the rationale for combining the references is that “one would want to combine improvements from *Scocca*, *Clements* '172, *Schubert* and *Schach* with the base invention of *Gonzales* in order to receive the well-known and expected benefits applicable to book publishing (e.g., proofing, preview, professional touches, hard covering).”

However, this rationale impermissibly incorporates hindsight reasoning as there is no language or teachings within the cited references to give any reasons to one of ordinary skill in the art to combine those references. Indeed, combination of the prior art references cited by the Examiner is further made difficult by *Clements '172* teaching away from the present invention and the

5 Examiner's application of *Gonzales* impermissibly changing the principle of operation of *Gonzales*.

For at least the reasons stated above, the Examiner's rejections under 35 U.S.C. § 103 are in error and should be withdrawn.

**VIII. APPENDICES****1. APPEALED CLAIMS LISTING (37 C.F.R. § 41.37(c)(1)(viii))**

1-20 (canceled).

21. (previously presented) A system for producing a storytelling book, comprising:

5 a software program in a computer having subroutines for

(a) accepting by the computer a first set of inputs from a user in a first blank story book screen, the first set of inputs comprising title information and author information and one or more images;

10 (b) automatically generating by the computer a cover page for printing on a first leaf's front-side from the first set of inputs, wherein the cover page includes at least one of title information, author information, and one or more images;

(c) automatically generating by the computer a title page for printing on the first leaf's back-side and a second leaf's front-side, wherein the title page includes the title and author information and a copyright notice information;

15 (d) accepting by the computer a second set of inputs from the user in a second blank story book screen, the second set of inputs comprising one or more images and corresponding text;

(e) automatically generating by the computer a first story page from the one or more images from the second set of inputs for printing on the second leaf's back-side and  
20 automatically proportionally enlarging the one or more images from the second set of inputs on the first story page to a maximum size that does not overlap margins of the first story page;

(f) automatically generating by the computer a second story page from the one or more images and the corresponding text from the second set of inputs for printing on a third

leaf's front-side, wherein the one or more images and corresponding text from the second set of inputs, when printed, appear oriented in diametric contraposition to the one or more images on the first story page;

(g) automatically generating by the computer one or more indicia on the title page

5 and first and second story pages for indicating how to assemble the second story page in diametric contraposition to the first story page; and

(h) allowing by the computer the user to print the cover page, the title page, and the first and second story pages, wherein the first story page and second story page are printed for binding the second story page in diametric contraposition to the first story page.

10 22. (previously presented) The system of claim 21, wherein said one or more indicia include binding instructions.

23. (previously presented) The system of claim 21, wherein said one or more indicia include page numbers.

15 24. (previously presented) The system of claim 21, wherein said one or more indicia include graphical symbols.

25. (canceled).

26. (previously presented) A method for producing a storytelling book, comprising:

(a) providing by a computer a first set of inputs from a user in a first blank story book screen to said software program, the first set of inputs comprising title information and author  
20 information and one or more images;

(b) automatically generating by the computer a cover page for printing on a first leaf's front-side from the first set of inputs, wherein the cover page includes at least one of title information, author information, and one or more images;

(c) automatically generating by the computer a title page for printing on the first leaf's back-side and a second leaf's front-side, wherein the title page includes the title and author information and a copyright notice information;

5 (d) providing by the computer a second set of inputs from the user in a second blank story book screen to said software program, the second set of inputs comprising one or more images and corresponding text;

(e) automatically generating by the computer first story page from the one or more images from the second set of inputs for printing on the second leaf's back-side and automatically proportionally enlarging the one or more images from the second set of inputs on  
10 the first story page to a maximum size that does not overlap margins of the first story page;

(f) automatically generating by the computer a second story page from the one or more images and the corresponding text from the second set of inputs for printing on a third leaf's front-side, wherein the one or more images and corresponding text from the second set of inputs, when printed, appear oriented in diametric contraposition to the one or more images on the first  
15 story page;

(g) automatically generating by the computer one or more indicia on the title page and first and second story pages for indicating how to assemble the second story page in diametric contraposition to the first story page; and

(h) printing, using the computer, the cover page, the title page, and the first and second  
20 story pages, wherein the first and second story pages are printed for binding the second story page in diametric contraposition to the first story page.

27. (previously presented) The method of claim 26, wherein said one or more indicia include binding instructions.

28. (previously presented) The method of claim 26, wherein said one or more indicia include page numbers.

29. (previously presented) The method of claim 26, wherein said one or more indicia include graphical symbols.

5 30. (canceled).

31. (previously presented) A kit for producing a storytelling book, comprising:

a software program in a computer having subroutines for

(a) accepting a first set of inputs from a user in a first blank story book screen, the first set of inputs comprising title information and author information and one or more images;

10 (b) automatically generating a cover page for printing on a first leaf's front-side from the first set of inputs, wherein the cover page includes at least one of title information, author information, and one or more images;

(c) automatically generating a title page for printing on the first leaf's back-side and a second leaf's front-side, wherein the title page includes the title and author information and  
15 a copyright notice information;

(d) accepting a second set of inputs from the user in a second blank story book screen, the second set of inputs comprising one or more images and corresponding text;

(e) automatically generating a first story page from the one or more images from the second set of inputs for printing on the second leaf's back-side and automatically  
20 proportionally enlarging the one or more images from the second set of inputs on the first story page to a maximum size that does not overlap margins of the first story page;

(f) automatically generating a second story page from the one or more images and the corresponding text from the second set of inputs for printing on a third leaf's front-side

wherein the one or more images and corresponding text from the second set of inputs, when printed, appear oriented in diametric contraposition to the one or more images on the first story page;

(g) automatically generating one or more indicia on the title page and first and  
5 second story pages for indicating how to assemble the second story page in diametric contraposition to the first story page;

(h) allowing the user to print the cover page, the title page, and the first and second story pages, wherein the first and second story pages are printed for binding the second story page in diametric contraposition to the first story page; and

10 a front cover that houses the printed cover page and binds with the printed title page, the first story page, the second story page, and a back cover, wherein the second story page is oriented in diametric contraposition to the first story page.

32. (previously presented) The kit of claim 31, wherein said one or more indicia include binding instructions.

15 33. (previously presented) The kit of claim 31, wherein said one or more indicia include page numbers.

34. (previously presented) The kit of claim 31, wherein said one or more indicia include graphical symbols.

35. (canceled).

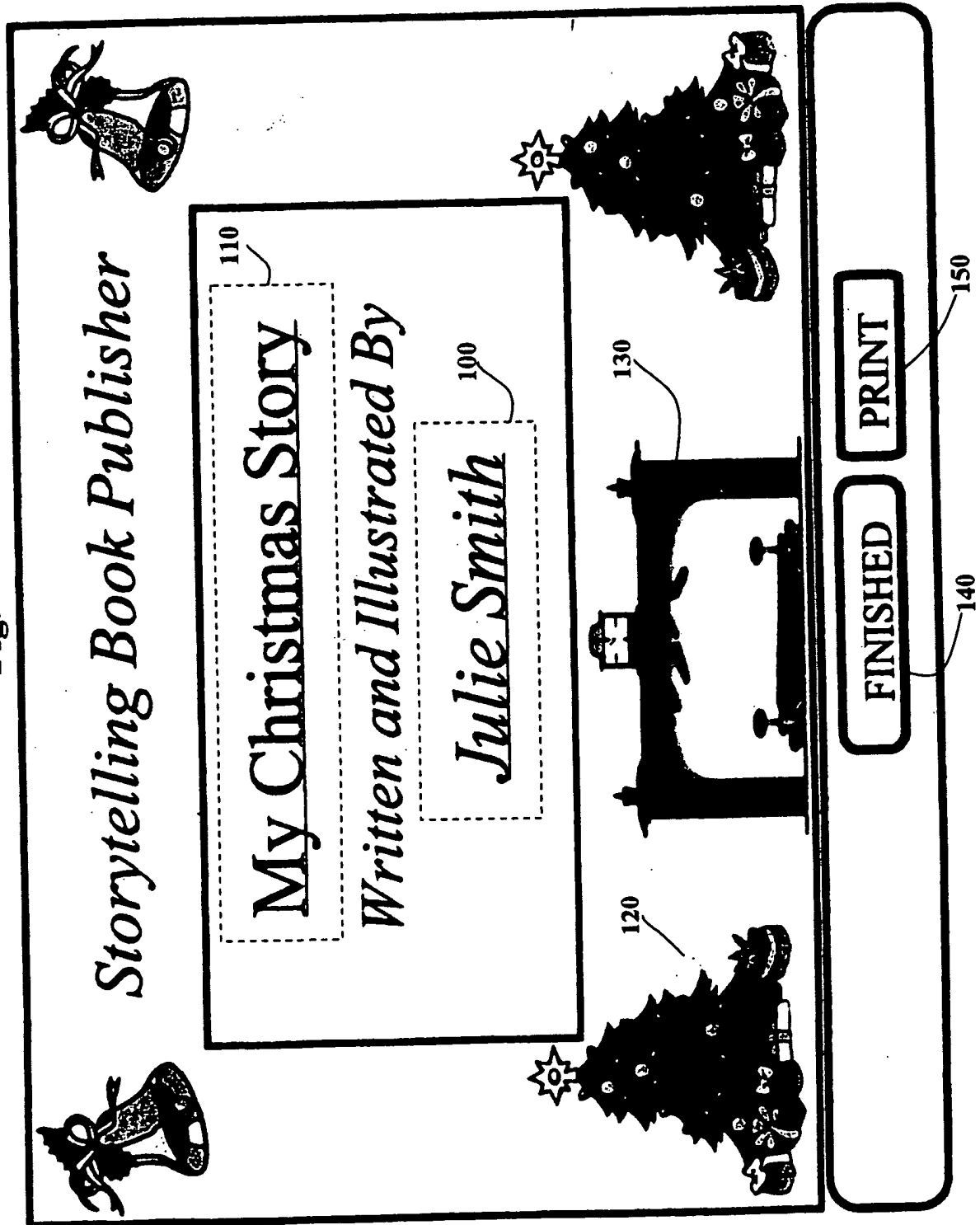
**2. EVIDENCE (37 C.F.R. § 41.37(c)(1)(ix))**

None



3. FIGURES

Fig. 1



*Fig. 2*

## *Storytelling Book Publisher*

software program encourages and facilitates the educational and creative process of writing and illustrating a story by a student in a school. The Storytelling Book Publisher software program is intended to be used in a school setting to help a student produce and print one copy of a story book that will be read aloud to the class and teacher in school, and to parents at home.

***My Christmas Story***  
*Written and Illustrated by*  
***Julie Smith***

Copyright 2004 Jehan Clements  
All Rights Reserved

200

PRINT

FINISHED

210

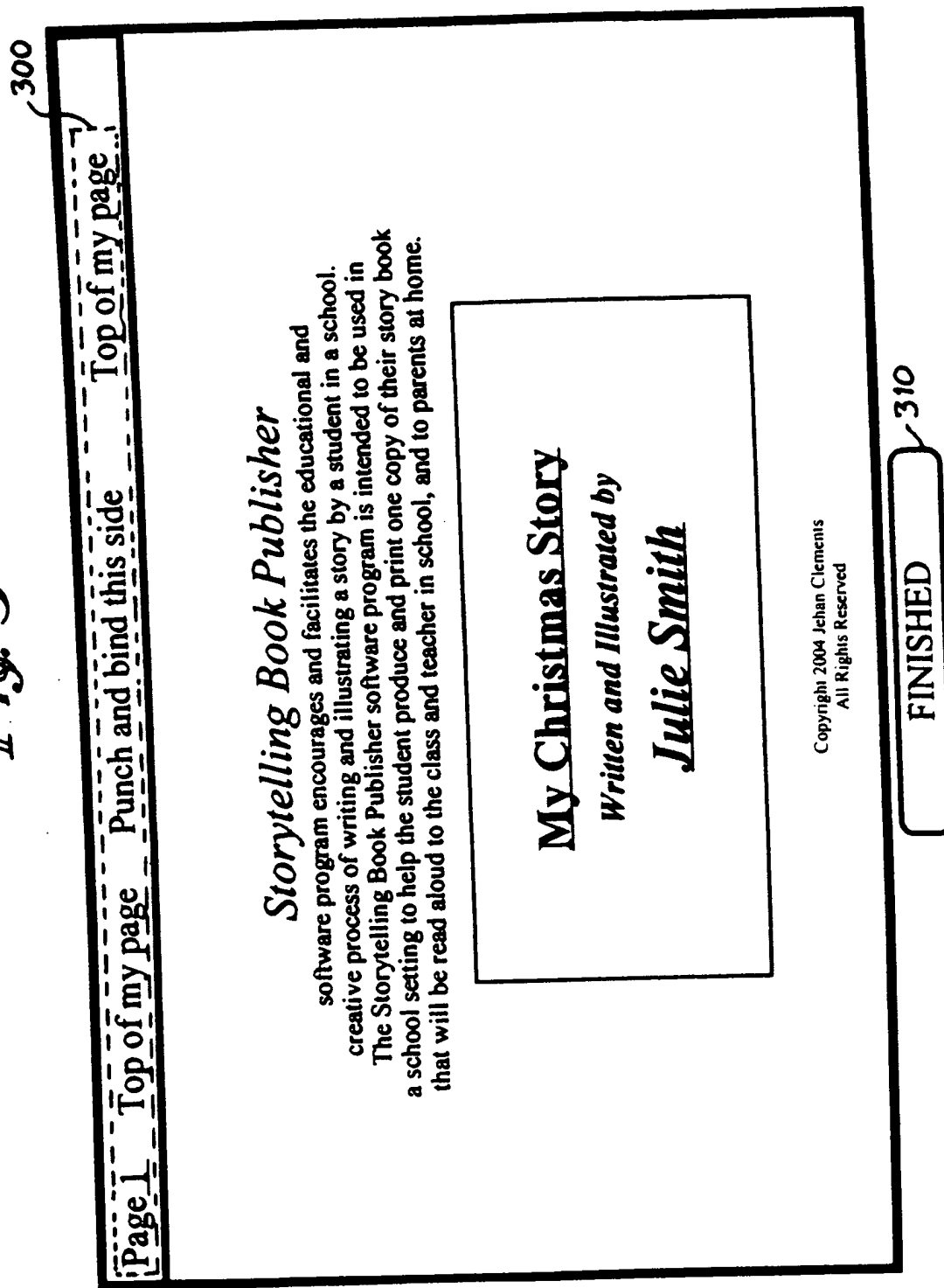
*Fig. 3*

Fig. 4

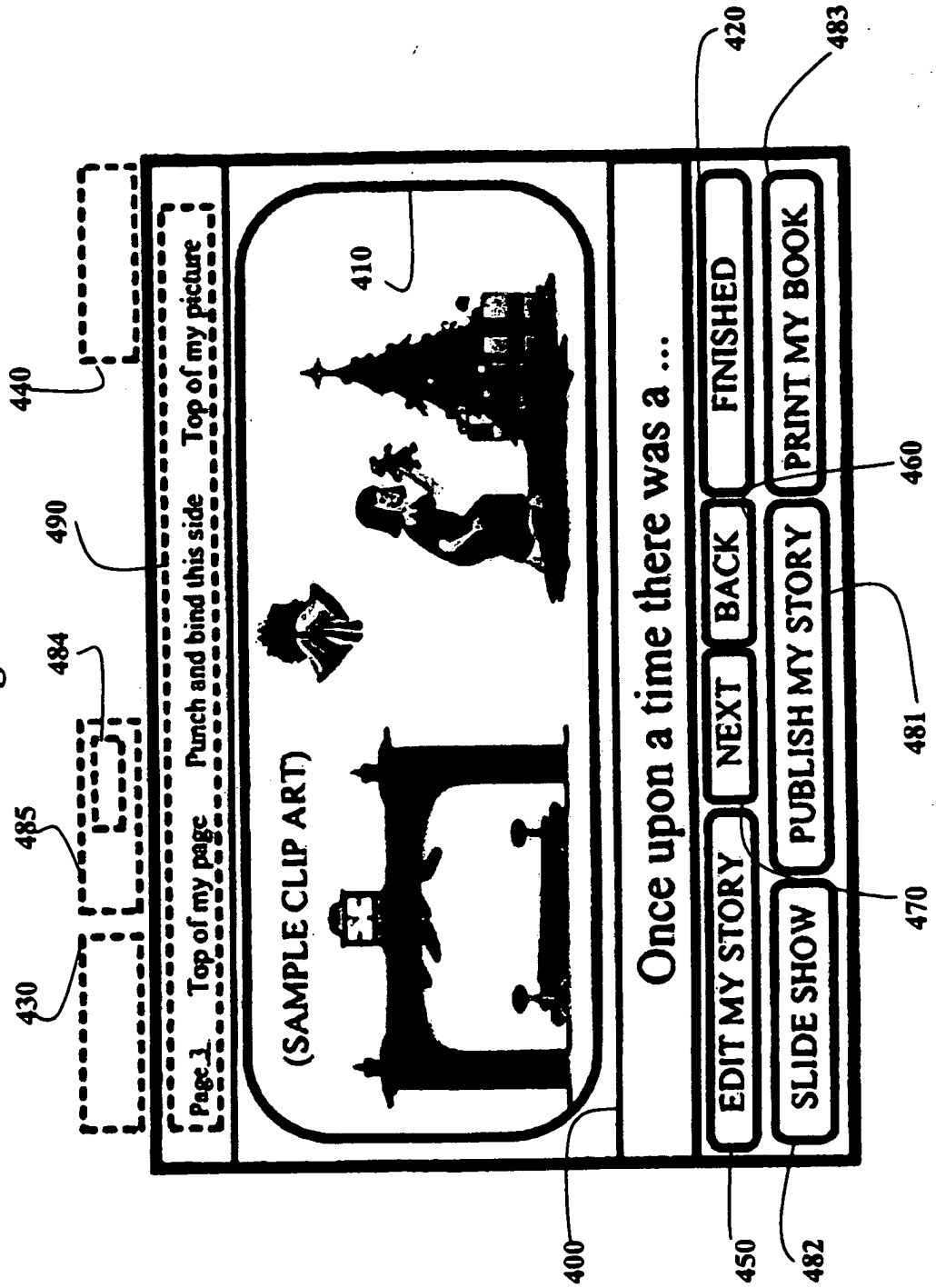
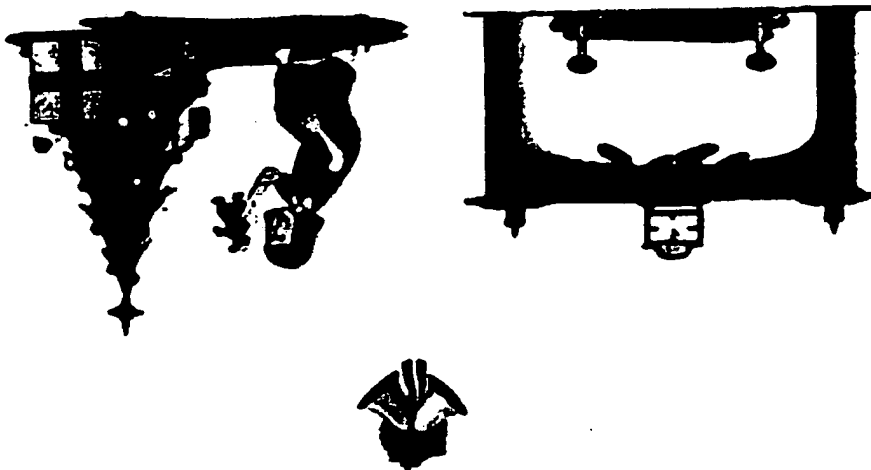


Fig. 5

520

PRINT SECOND SIDE

Once upon a time there was a ...



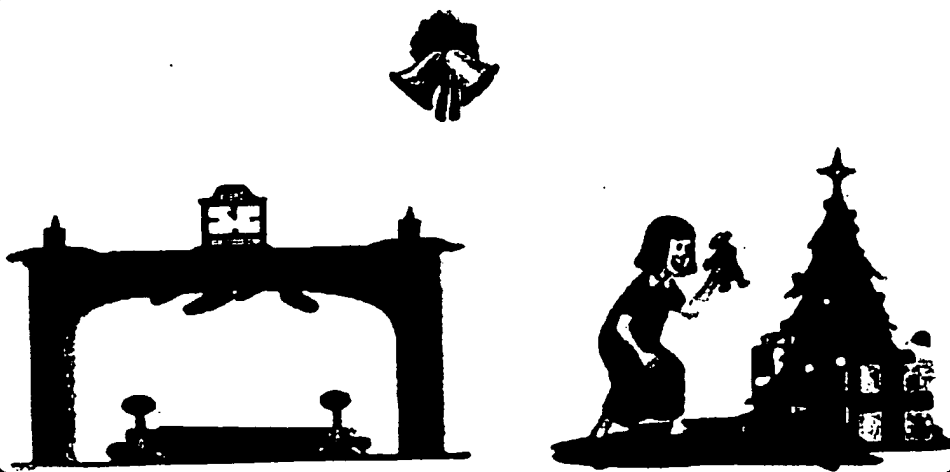
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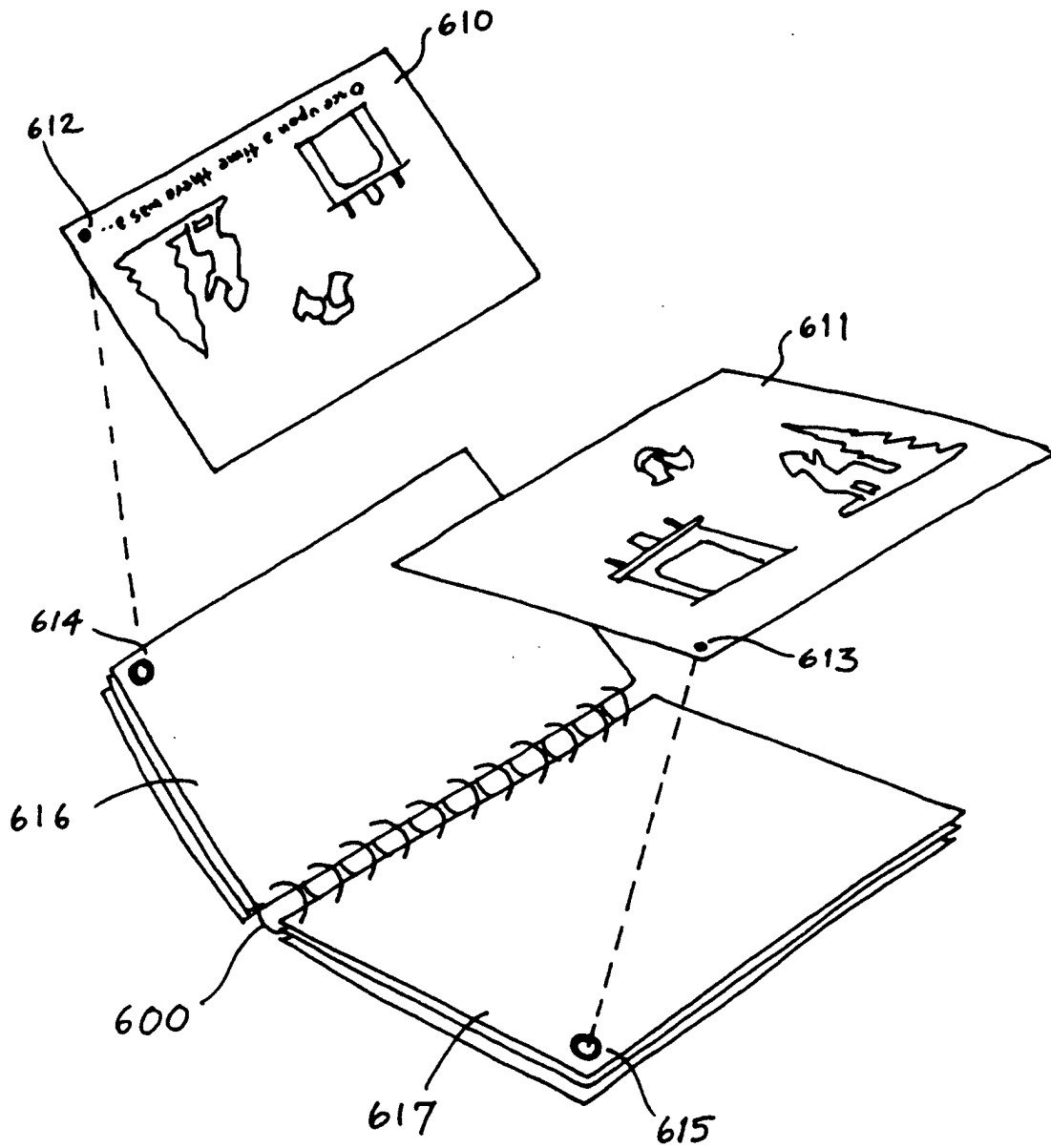
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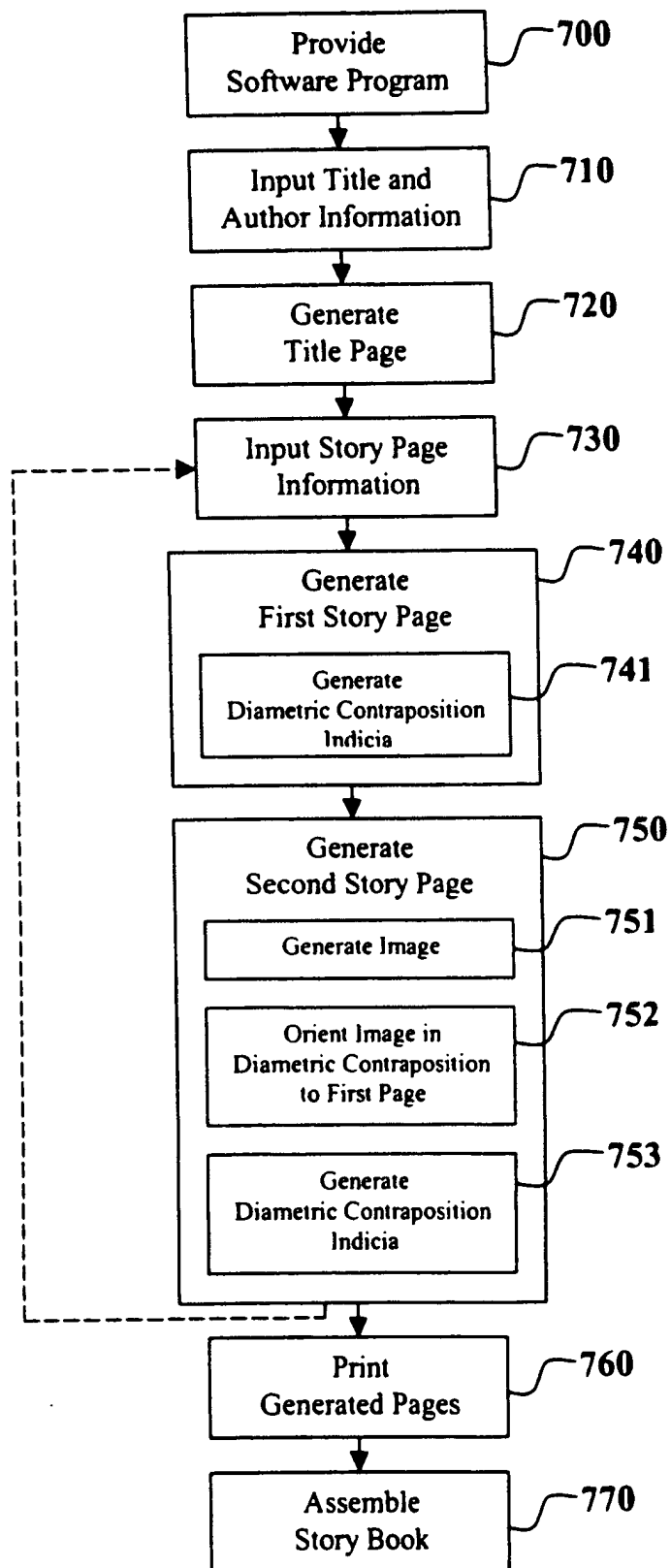
PRINT FIRST SIDE



510



*Fig. 6*



*Fig. 7* 47

**IX. RELATED CASES (37 C.F.R. § 41.37(c)(1)(x))**

NONE




**CONCLUSION**

Applicants respectfully requests reconsideration and withdrawal of the pending rejection over *Gonzales, Scocca, Clements '172, Schubert, and Schach*.

The Commissioner is authorized to charge any additional fees associated with this brief, or credit any overpayment, to Deposit Account No. 13-3250. **EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 13-3250 (Reference No. 02013.06034). This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

**MILBANK, TWEED, HADLEY & McCLOY LLP**

By:   
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